

427468

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/427,468

04/24/95

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J&J-1500

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33M1 / 1010

REICHLER EXAMINER

## ART UNIT

**PAPER NUMBER**

3308

36

**DATE MAILED:**

10/10/95

**This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS**

☒ This application has been examined      ☒ Responsive to communication filed on 4-24-95      ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 5 month(s), 1 days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1. ☐ Notice of References Cited by Examiner, PTO-892. 2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.  
3. ☐ Notice of Art Cited by Applicant, PTO-1449. 4. ☐ Notice of Informal Patent Application, PTO-152.  
5. ☐ Information on How to Effect Drawing Changes, PTO-1474. 6. ☐ \_\_\_\_\_.

## Part II SUMMARY OF ACTION

1. ☒ Claims 1-5, 9-12, 14-21 and 23-26 are pending in the application.
- Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 1-5, 9-12, 14-21 and 23-26 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☒ been filed in parent application, serial no. 07 1927 849; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other \_\_\_\_\_

### EXAMINER'S ACTION

The oath or declaration is objected to for the reasons set forth on page 2, lines 1-9 of a previous Office Action, Paper No. 28.

*MR 10-3-95*  
The drawings are objected to for the reasons set forth on page 2, lines 10-14 of a previous Office Action, Paper No. 28.

The amendment filed August 22, 1994 is objected to under 35 U.S.C. § 132 because it introduces new matter into the specification. 35 U.S.C. § 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: page 3, lines 20-21, page 4, line 27.

Applicant is required to cancel the new matter in the response to this Office action.

See discussion of declaration and Applicant's remarks, infra.

*MR 10-3-95*  
The specification is objected to for the reasons set forth on page 3, line 11 - page 4, line 2 and page 4, lines 5-9 of a previous Office Action, Paper No. 28. Also, see new matter objection, supra,

*MR 10-3-95*  
Claims 1-5, 9-12, 14-21 and 23-26 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 1-5, 21 and 23-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 1, line 8, "core" should be --portion-- to be consistent. In regard to claim 24, a positive structural antecedent basis for "tape-shaped nonwoven material" should be defined.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1, 20, 21, 23 and 25 are rejected under 35 U.S.C.

§ 102(b) as anticipated by or, in the alternative, under 35 U.S.C.

10-3-95 § 103 as obvious over Forsman. See Figs. 24, 25, 105 and side view. The tampon is or obviously is identical to the tampon claimed in product by process claims 1 and 20-21, claims 23 and 25. See MPEP 706.03(e).  
Claims 24 and 26 are rejected under 35 U.S.C. § 103 as being

unpatentable over Forsman.

Applicant claims a tape-shaped nonwoven material which is needled and the core diameter. Forsman does not teach the nonwoven being needled or the diameter. However, see page 2, lines 9-10, i.e. "preferably", and page 3a, line 16, i.e. "is appropriate", i.e. no criticality disclosed. Therefore, it would be obvious matter of design choice to employ the claimed nonwoven and diameter on the Forsman device as Applicant has not disclosed that such features solve any stated problem or are for any particular purpose and it appears the tampon would work equally well with various non-woven and diameters.

Claims 1, 20-21 and 23-26 are rejected under 35 U.S.C. § 103 as being unpatentable over Rabell in view of Bailey.

The Rabell device includes all the claimed structure except for a solid core. However, Bailey teaches that spirally wound blank, e.g., Figs. 13-14, or a folded blank, e.g., Figures 1-4, are equivalents for use in forming a compressed tampon. To make the folded blank of Rabell a spiral blank instead would be obvious to one of ordinary skill in the art in view of the equivalence as taught by Bailey. In regard to claims 24 and 26, see discussion supra of claims 24 and 26 which discussion also applies here. In regard to claims 21 and 25, Applicant claims the ribs contact an adjacent rib at a point adjacent its distal end. However, see amendment to page 4, line 27, i.e. no criticality of configuration over open groove configuration or combination groove configuration. Therefore, it would have been obvious design choice to make the

groove configuration closed on the Rabell device as Applicant has not disclosed that such features solve any stated problem or one for any particular purpose and it appears the tampon would work equally well.

The remainder of the claims distinguish over the art.

In regard to Applicant's last remarks on page 6, lines 23-29, such remarks have been noted but neither a new declaration or proposed Figure 10 has been, as of yet, made of record in the application.

In regard to Applicant's last remarks on page 6, line 30 - page 7, line 10 and page 7, lines 16-18 with regard to 1) and 3), such objections have not been repeated.

In regard to Applicant's last remarks on page 6, line 30 - page 7, line 2, page 7, lines 11-15 and 20 et seq and page 8, lines 1 et seq, Applicant's remarks and the Engqvist declaration have been considered but are deemed nonpersuasive. Specifically, while the Engqvist declaration sets forth that commercial tampons expend and include several variables, there is no evidence set forth in the declaration, i.e. no scientific tests were conducted by affiant, as best determinable from the declaration, to support the conclusory statements on the last 10 lines of page 3, i.e. no evidence of the groove configurations now disclosed as being implicit or inherent in the disclosed method of making and product made. Nor is there an explicit description in the originally filed specification which shows Applicant contemplated any groove

configuration except that which is open.

Furthermore, there are no supporting statements in the Engqvist declaration for Applicant's representative's statement on liens 24 et seq of page 8.

In regard to Applicant's remarks on page 9, lines 1-8, Applicant's remarks have been considered but are deemed non-persuasive in that 2mm or 4mm and 2mm to 4mm, i.e. the range of 2 to 4mm, are not the same.

In regard to Applicant's remarks on page 9, line 13-page 11, line 2, Applicant's remarks have been considered but either the rejections not been repeated or have not been overcome, i.e. the 35 USC 112, second paragraph, rejection of claim 1, line 8.

This is a continuation of applicant's earlier application S.N. 124,374. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE

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ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to K. Reichle at telephone number (703) 308-2617.

*K.M. Reichle*  
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PATENT EXAMINER  
ART UNIT 338

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September 28, 1995  
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